



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,408	06/07/2001	Charles P. Brown	00,464-A	7316
32097 7590 09/01/2009 LESAVICH HIGH-TECH LAW GROUP, P.C. SUITE 325 39 S. LASALLE STREET CHICAGO, IL 60603				
EXAMINER NGUYEN, TAN D				
ART UNIT		PAPER NUMBER		
3689				
MAIL DATE		DELIVERY MODE		
09/01/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/876,408

Applicant(s)

BROWN, CHARLES P.

Examiner

Tan Dean D. Nguyen

Art Unit

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-33 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date: _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment filed 6/2/09 has been entered. Claims 1-33 are pending. Claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 23, 24, 25, 26, 29, 30, 31, 32 and 33 **have been amended**. Claims 1, 14, 19, 25, 30 and 32 are independent claims. The claims comprise 6 groups/set of claims:

- 1) method: 1-13,
- 2) method: 14-18,
- 3) method: 19-24,
- 4) method: 25-29,
- 5) system: 30-31, and
- 6) system: 32-33.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13, drawn to a method for **protecting domain name registrations**, classified in class 705, subclass 1.

Independent Claim 1 comprises a plurality of new steps of:

- a) receiving a request....,
- b) receiving a one-time permanent registration....,
- c) creating a permanent registration ...,
- d) issuing a permanent registration certificate ..., and
- e) providing access to the

- II. Claims 14-18, drawn to a method for **providing permanent registration**,
classified in class 705, subclass 40.

Independent Claim 14 comprises a plurality of steps of:

- a) generating a list of existing domain name registrations ...,
- b) paying automatically all renewals fee payments ...,
- c) querying the public domain name register ...,
- d) transferring additional renewal fee payments,
- e) notifying administrators ..., and
- f) repeating steps (a)-(c) periodically,

- III. Claims 19-24, drawn to a method for **providing a permanent web-site**,
classified in class 705, subclass 7 or 26.

Independent Claim 19 comprising a plurality of steps of:

- a) accepting a domain name for which,
- b) accepting electronic content for a permanent web-site ...,
- c) accepting a one-time permanent web-site fee....,
- d) hosting a permanent web-site

- IV. Claims 25-29, drawn to a method of **providing co-use** of a permanent registration of a domain name, classified in class 705, subclass 8.
- Independent Claim 25 comprising plurality of steps:
- a) hosting a permanent domain name on a network server,
 - b) receiving a request for electronic content ...,
 - c) determining which one of the plurality of co-users ...,
 - d) directing the request to the determined co-user.
- V. Claims 30-31, drawn to a permanent domain name **system** (apparatus), classified in class 709, subclass 203 or class 705, subclass 35.
- Independent claim 30 basically comprises of:
- a) a first server.....,
 - b) a plurality of other servers ... for **determining, paying and verifying all current and future renewal fees....**
- VI. Claims 32-33, drawn to a permanent domain name **system** (apparatus), classified in class 709, subclass 203 or class 705, subclass 1 or 35.
- Independent claim 32 basically comprises of:
- a) a first server.....,
 - b) a permanent **web-site** for permanently hosting a web-site ..., and
 - c) a plurality of other servers ... for **hosting a permanent website.**

The inventions are distinct, each from the other because of the following reasons:

3. Inventions (I, II, III, IV) and (V, VI) are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, **or** (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be used for distributed data processing with issues respecting general business registration or website hosting.
1. Inventions I, II, III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions have different modes of operations and effects as shown in the claimed steps above and are not capable of use together even though they may have one common step because they basically have different scope as shown in the preamble and last step of the claim which normally reflect the scope.
2. Inventions V and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions have different designs and effects are not capable of use together even though they may have one common element because they basically have different scope as shown in the last element of the claim which normally reflect the scope.

3. For example in independent apparatus claim 32, it has a permanent web-site for permanently hosting a website and services associated with this website. This is distinct from independent apparatus claim 30 which basically deal with setting a plurality of other servers for determining, paying and verifying all current and future renewal fees, even though they both have a first server.

4. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a **serious search and examination burden** if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected invention.** For example, Group I, claims 1-13.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).
6. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
7. Any response to this action should be mailed to:
Commissioner of Patents and Trademarks
Washington, D.C. 20231
or faxed to **571-273-8300**.
Hand delivered responses should be brought to the
US Patent and Trademark Office Customer Service Window:
Randolph Building
401 Dulany Street
Alexandria, VA 22314.
8. In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.
9. Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number **(571) 272-6806**. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday. Should I be unavailable during my normal working hours, my supervisor Janice Mooneyham can be reached at **(571) 272-6805**. The main **FAX phone** numbers for formal communications concerning this application are **(571) 273-8300**. My personal Fax is **(571) 273-6806**. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689